

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006
RECEIVED
CENTRAL FAX CENTER
NOV 21 2006

REMARKS

Claims 1-3, 5-14, and 21-27 are currently pending in the application. Claims 1, 9 and 25 are independent. No new matter has been added to the claims. Applicants respectfully request reconsideration of the present application.

Rejection of Claims 1-3 and 7-8

Claims 1-3 and 7-8 stand rejected as being unpatentable over Singkornrat in view of Jung and further in view of Jaaskelainen (U.S. Patent. No. 5,963,191). Applicant respectfully disagrees.

With respect to claim 1, claim 1 is patentable over Singkornrat in view of Jung and further in view of Jaaskelainen because, in the very least, none of the references, considered alone or in combination, disclose all of the features of claim 1. As the Office correctly noted, Singkornrat and Jung fail to teach a display driver that is "configured to translate data between the monitor wireless transceiver and the computer display device," as is required by claim 1. The Office contends that this feature of claim 1 is disclosed by Jaaskelainen and that it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of Jaaskelainen with those of Singkornrat and Jung. The Office's contention lacks merit for at least three reasons: (1) Jaaskelainen does not teach or suggest a display driver configured to translate data between a wireless transceiver and a display device; (2) Jaaskelainen is non-analogous to the invention claimed; and (3) the Office has not provided any suggestion or motivation to combine the references and there appears to be no such suggestion or motivation.

(1) Jaaskelainen Does Not Teach or Suggest the Claimed Display Driver.

Contrary to the Office's contention, Jaaskelainen does not teach or suggest a "display driver configured to translate data between the monitor wireless transceiver and the computer display device," as is required by claim 1. The Jaaskelainen patent teaches "the graphical pointer signal is passed to display device driver 106, which routes the data within the graphical pointer signal and other display data to display adapter 70, which translates the display data into the R, G, and B signals utilized to drive display device 14." (Col. 7, Lines

*Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006*

19-25) (emphasis added). Accordingly, Jaaskelainen discloses that the device that translates the data is the "display adapter," not the "driver." Claim 1, on the other hand, requires a "display driver configured to translate data between the wireless transceiver and the computer monitor device" (emphasis added). Therefore, Jaaskelainen does not disclose the claimed display driver (*i.e.*, a display driver that is configured to translate data between a wireless transceiver and a computer monitor device). Thus, even if Jaaskelainen were combined with the other references, the combination would not achieve the invention as defined by claim 1.

(2) Jaaskelainen is Non-Analogous Prior Art.

Jaaskelainen may not be used as a prior art reference under §103 because it is non-analogous. See MPEP §2141.01(a); State Contr. & Eng'g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1069 (Fed. Cir. 2003); Wang Lab. v. Toshiba Corp., 993 F.2d 858, 864 (Fed. Cir. 1993); In re Clay, 966 F.2d 656, 658-659 (Fed. Cir. 1992). Courts have established a two-pronged test to determine whether prior art is analogous:

Two criteria are relevant in determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the art is not within the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved.

Wang Labs, 993 F.2d at 864. Applying this test to Jaaskelainen establishes that Jaaskelainen is not analogous prior art. Under the first prong, prior art must be in the same field of endeavor. The field of endeavor of the present invention is computer systems including a wireless monitor, while the field of endeavor of Jaaskelainen is methods and systems of user interface display, for data processing systems. Jaaskelainen's method and system for denying a pointer access to a particular region of a display is completely different from a wireless computer monitor; they are different technologies and used for different purposes. Thus the first prong is not met under the Wang Labs test because a method and system for denying a pointer access to a particular region of a display is in a different field of endeavor than a wireless computer monitor.

A piece of prior art may still be asserted as analogous under Wang Labs' second prong if it is reasonably pertinent to the particular problem to be solved. A method and

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

system for denying a pointer access to a particular region of a display, however, is not pertinent to the problem of how to establish communication between a computer and a wireless monitor. Thus the second prong of the Wang Labs test is not satisfied.

(3) The Office Has Provided No Suggestion or Motivation to Combine Jaaskelainen with the Other References

There is no suggestion or motivation to combine Jaaskelainen with the other references. In order for the Office to establish a *prima facie* case of obviousness, there must be "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2143; see also In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006) (noting that "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole").

In this case, the Office seeks to modify Jung to incorporate the teachings of Jaaskelainen with regard to a display driver that translates data provided by a controller. But, the Office has failed to articulate why a person of ordinary skill in the art would be motivated to make the modification. The Office merely states in a conclusory fashion that it would have been obvious to combine the references. The Office's failure to provide any suggestion or motivation to combine the references¹ is unsurprising because none exists.

Both Jung and Singkornrat provide fully functional means to present information visually to a user, and they do so without requiring a display driver configured to translate data for the display. Accordingly, even if we were to assume for the sake of argument that the display driver of Jaaskelainen translates data, incorporating the display driver of Jaaskelainen into Jung or Singkornrat would provide no added advantage. In fact, incorporating the Jaaskelainen display driver into the system disclosed in Jung would make the system more complex and costly without adding any benefit. Thus there is no suggestion or motivation to combine Jaaskelainen with the other references.

In conclusion, the office action has failed to establish a *prima facie* case for obviousness because: (1) the cited prior art references fail to teach or suggest all of the

¹ When the Office fails explain a suggestion or motivation to combine, the Federal Circuit has held that it will assume that the Office has improperly used hindsight in coming to the conclusion of obviousness. See e.g. In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006).

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

elements of claim 1; (2) Jaaskelainen is non-analogous prior art; and (3) there is no suggestion or motivation to combine the references.

Applicant, therefore, respectfully requests that the rejection of claim 1, and claims 2-3 and 7-8, which depend from claim 1, be withdrawn.

Rejection of Claim 9-11, 21-23

Claims 9-11, and 21-23 stand rejected as being obvious over Singkornrat in view of Brinsfield (U.S. Patent. No. 6,870,484). Applicant respectfully disagrees.

With respect to claim 9, the Office has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Office must establish the following three elements:

[F]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143. Because the Office Action failed to establish the existence of at least two of these criteria, rejection of claim 9 under §103(a) is improper.

As an initial note, Applicant respectfully submits that the Office has failed to provide any suggestion or motivation to combine the teachings of Brinsfield with that of Singkornrat. The Federal Circuit has noted that “when the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.” In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006).

Additionally, even if there were a suggestion or motivation to combine the prior art, the prior art cited does not teach or suggest all the claim limitations of the rejected claims. The Office correctly states that Singkornrat “fails to teach a computer main unit having a unique address.” The Office incorrectly contends, however, that Brinsfield makes up for the deficient teachings of Singkornrat.

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

Brinsfield does not teach or suggest a "monitor wireless transceiver configured to communicate to the computer wireless transceiver, wherein said communication includes data and said unique address [of the computer main unit]," as is required by claim 9. Instead, Brinsfield discloses a system that includes: (1) a central station 14 (*i.e.*, a computer main unit), (2) a plurality of antennas 54, wherein each antenna is assigned a unique address, and (3) a portable telemetry monitor 98 having a unique address.

As disclose in Brinsfield, each antenna 54 periodically broadcasts its unique address so that when a telemetry monitor 98 is in range of one of the antennas 54, the telemetry monitor 98 will receive the address of the antenna 54. When the telemetry monitor 98 has data to transmit to the central station 14, the telemetry monitor 98 combines the received antenna address with the data and then transmits the combined address and data to the antenna array.

Brinsfield also discloses that the telemetry monitor 98 has a unique address. According to Brinsfield, when the central unit 14 has data to send to monitor 98, the "data is sent with a header address that is unique to each individual portable telemetry monitor 98." *Col. 4, lines 38-41.*

Significantly, nowhere does Brinsfield teach or suggest a communication to the central unit 14 that includes a unique address assigned to the central unit 14. Rather, the only address included in any communications to central unit 14 is the unique address of an antenna 54. Accordingly, Brinsfield does not teach or suggest a "monitor wireless transceiver configured to communicate to the computer wireless transceiver, wherein said communication includes data and said unique address [of the computer main unit]," as is required by claim 9 (emphasis added). For this reason alone, the rejection of claim 9 should be withdrawn.

Furthermore, Brinsfield may not be used as a prior art reference under §103 because it is non-analogous. See MPEP §2141.01(a); State Contr. & Eng'g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1069 (Fed. Cir. 2003; Wang Lab. v. Toshiba Corp., 993 F.2d 858, 864 (Fed. Cir. 1993); In re Clay, 966 F.2d 656, 658-659 (Fed. Cir. 1992). Courts have established a two-pronged test to determine whether prior art is analogous:

Two criteria are relevant in determining whether prior art is analogous: (1) whether the art is from the same field of endeavor,

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

regardless of the problem addressed, and (2) if the art is not within the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved.

Wang Labs, 993 F.2d at 864. Applying this test to Brinsfield establishes that Brinsfield is not analogous prior art. Under the first prong, prior art must be in the same field of endeavor. The field of endeavor of the present invention is computer systems including a wireless monitor, where the field of endeavor of Brinsfield is patient monitoring systems that allow a patient to ambulate through the care unit of a clinical facility. Brinsfield's patient monitoring system is completely different from a wireless computer monitor; they are different technologies and used for different purposes. Thus the first prong is not met under the Wang Labs test because a patient monitoring system is in a different field of endeavor than a wireless computer monitor.

A piece of prior art may still be asserted as analogous under Wang Labs' second prong if it is reasonably pertinent to the particular problem to be solved. A patient monitoring system, however, is not pertinent to the problem of how to establish communication between a computer and a wireless monitor. Thus the second prong of the Wang Labs test is not satisfied.

In sum, the Office has failed to make a *prima facie* case of obviousness with respect to claim 9 because neither Singkornrat nor Brinsfield, considered alone or in combination, teach or suggest all the claim limitations. Additionally, there is also no evidence offered that the combination of the Singkornrat and Brinsfield patents was suggested or motivated by the prior art references. Finally, Brinsfield is non-analogous prior art.

Applicant, therefore, respectfully requests that the rejections of claim 9 and claims 10-11 and 21-23, which depend from claim 9, be withdrawn.

Rejection of claims 25-26

Claims 25-26 stand rejected as being unpatentable over Riazzi (U.S. Patent. No. 6,748,005) in view of Jung (U.S. Patent. No. 6,041,225) and further in view of Jaaskelainen (U.S. Patent. No. 5,963,191). Applicant respectfully traverses.

With regard to claim 25, claim 25 is patentable over Riazzi in view of Jung and further in view of Jaaskelainen because neither Riazzi nor Jung nor Jaaskelainen, considered

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

alone or in combination, disclose all of the elements of claim 25. As the Office correctly noted Riazzi and Jung fail to teach a display driver configured to translate data for the display². The Office then improperly relies upon Jaaskelainen for the elements of claim 25 that remain untaught by Riazzi and Jung. As noted in the discussion relating to the rejection of claim 1, supra, Jaaskelainen does not disclose a display driver configured to translate data. Accordingly, Applicant respectfully requests that the rejections of claim 25 and claim 26, which depends from claim 25, be withdrawn.

Rejection of Claim 5-6

Claims 5-6 depend from claim 1, and, therefore, are patentable for at least the reason given above with respect to claim 1.

Rejection of Claims 12-13, 14 and 24

These claims depend from claim 9, and, therefore, are patentable for at least the reason given above with respect to claim 9.

Rejection of Claim 27

Claim 27 depends from claim 25, and, therefore, is patentable for at least the reason given above with respect to claim 25.

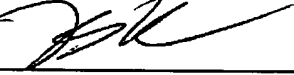
CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

² The Office actually notes that Singkornrat and Jung, in combination, fail to teach this element, but Applicant assumes this is an error as Singkornrat was not a basis for the rejection of claim 25.

Appl. No. 09/994,634
Reply to Office Action Dated July 21, 2006

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Brian Rosenbloom, Registration No.: 41,276				
SIGNATURE				DATE	11/21/06
Address	Rothwell, Figg, Ernst & Manbeck Suite 800, 1425 K Street, N.W.				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031